

REMARKS

Please note the fact that June 25, 2005, fell on a Saturday ensures that this paper is timely filed as of today, Monday, June 27, 2005 (the next succeeding day which is not a Saturday or Sunday).

In the Office Action dated March 25, 2005, pending Claims 9-12 were rejected and the rejection made final. In response Applicant has filed herewith a Request for Continued Examination, has cancelled Claims 9-12 without prejudice, and has added Claims 13-26, which are directed toward further features of the present invention. Claims 13 and 19 are independent claims; the remaining being dependent claims. As will be discussed below, the claims as presently amended satisfy the requirements of 35 U.S.C. §112, first and second paragraphs, as well as being fully distinguishable over the cited prior art and are, thus, presently in condition for allowance. The Applicant intends no change in the scope of the claim by the changes made by these amendments. It should also be noted these amendments are not in acquiescence of the Office's position on allowability of the claims, but merely to expedite prosecution.

Applicant and the undersigned are most grateful for the time and effort accorded the instant application by the Examiner. On June 1, 2005, Applicant's counsel conducted a telephone interview with the Examiner in which the present application and the rejections made in the outstanding Office Action were discussed. No agreement, however, was reached with respect to the claims of the present application.

Section 112 Rejections

Claims 9-12 stand rejected under 35 U.S.C. § 112, first paragraph, as containing subject matter that was not described in the specification in such a way as to reasonably convey to one skilled in the art that the inventor had possession of the claimed invention at the time of filing the application. Claims 9-12 also stand rejected under 35 U.S.C. § 112, second paragraph, as being indefinite. As indicated above, Claims 9-12 have been cancelled and new Claims 13- 26 have been added. To the extent that the previous grounds for rejection may be seen to be applicable to the current amended claims the following discussion is presented to point out why such rejections would be improper.

In the present Office Action, the Examiner found that “[s]table support throughout at least a major portion of the interior opening in the rim” was not supported in the application, because “Applicant only describes the material extending far enough around in circumference to meaningfully connect with the interior opening of the rim of the tire. There is no mention that this extent is greater than a major portion of the interior opening of the rim.” (Office Action, Page 2) Furthermore, with respect to cancelled claims 11-12, the Examiner stated, “[t]here is no support in the specification as originally filed for ‘the material to provide support and contact...of at least about 240 degrees,’” since “[t]here is no mention of any particular angular or circumferential extent of the material, only that the important thing is that it extends far enough around in circumference to meaningfully connect with the rim of the spare tire.” *Id.*

In the Applicant’s Description of the Preferred Embodiments it is stated, *inter alia*:

As shown, tire spinner 170 is circular in nature and is solid for approximately two-thirds of a circle. This is a design choice which uses less material. The important consideration is for the tire spinner 170 to extend far enough around in circumference to meaningfully connect with the interior opening in the rim of the tire 220 when pivot arm 130 is in the lowered position. Indeed, there is no reason why tire spinner 170 could not have an unbroken circumference.

(Page 14, line 18 - Page 15, line 4) From this statement it is clear that the material of the tire spinner must be extent so as to be capable of a meaningful connection. The connection is meaningful if it “[p]ermits [a] tire 220 to be supported while the rim of [the] tire 220 is aligned with lug nuts 160.” (Page 14, lines 9-10) It naturally follows that the connection would not be meaningful if it failed to provide support such that the invention could not be performed, i.e., the tire could not be supported while it was aligned. A circumference of two-thirds (or 240 degrees) is expressly given as one possible embodiment, as is any circumference of up to and including 360 degrees; all of which are embodiments within the application’s use of meaningful connection.

While the language rejected in Claim 9 has not been retained in the current amended claims, language similar thereto has been; e.g., at least 240 degrees; up to 360 degrees; extent between 240 and 360 degrees; and extent 360 degrees. Because the disclosure clearly includes these embodiments, as indicated above, each of these claims meets the requirements of 35 U.S.C. § 112, first paragraph, such that one skilled in the art would consider them supported by the disclosure. *See In re Wertheim*, 541 F.2d 257, 191 USPQ 90 (CCPA 1976) (holding a range falling within the range disclosed was properly supported).

Cancelled Claim 10 was rejected under §112, second paragraph, because the term “meaningfully connect” was said to be indefinite. Claims 18 and 26 recite this language in the current amended claims. “In reviewing a claim for compliance with 35 U.S.C. §112, second paragraph, the examiner must consider the claim as a whole to determine whether the claim apprises one of ordinary skill in the art of its scope and, therefore, serves the notice function required by 35 U.S.C. §112, second paragraph, by providing clear warning to others as to what constitutes infringement of the patent. See, e.g., *Solomon v. Kimberly-Clark Corp.*, 216 F.3d 1372, 1379, 55 USPQ2d 1279, 1283 (Fed. Cir. 2000). See also *In re Larsen*, No. 01-1092 (Fed. Cir. May 9, 2001) (unpublished)” MPEP § 2173.02 (2005). As was discussed above, meaningfully connect does have a meaning to one skilled in the art in light of the whole claim to a tire spinner of which it is a part. The term must encompass tire support such that a tire can be aligned with the lug nuts. Therefore, it is respectfully submitted that the same rejection would be improper if applied to the new claims.

The Examiner has also rejected Claims 11-12 as being indefinite, because “[i]t is unclear how the extent of the material being 240 degrees would support or meaningfully connect with the interior opening of the rim beyond the upper or 180 degrees of the material as below this point, the material would no longer be supporting the spare tire.” (Office Action, Page 3) The current claims reciting, *inter alia*, tire support material having a particular extent and the claims that recite “meaningfully connect” are dependent claims, however, they are not dependent upon one another. Therefore, there is no confusion or indefiniteness as to how a particular circumference extent would

meaningfully connect with the opening of the tire's rim. For instance, Claim 16 indicates, wherein the circumference of the material is extent 360 degrees, while Claim 18 indicates, wherein the circumference of the material is extent to meaningfully connect with the interior opening of a tire rim. Neither of the claims is dependent upon the other, therefore, the confusion which served as the basis for the rejection of the now cancelled claims is not present. Any similar future rejection would, thus, be improper.

Section 102(b) and 103(a) Rejections

Claims 9-12 have been rejected under 35 U.S.C. §102(b) as being independently anticipated by Hansen (US 4,679,717); Japanese reference 8-258755; and Japanese reference 8-295266. Additionally, Claims 11-12 stand rejected under 35 U.S.C. §103(a) as being unpatentable over Hansen. The present claims are fully distinguishable over the aforementioned art.

As best understood, both Hansen and Japanese reference 8-295266 appear to be directed to exteriorly mounted spare tire carriers having a rest which provides means for supporting the spare tire while it is manually rotated for alignment with threaded studs. Additionally, it seems that support may possibly be provided to the tire, in each of these references, throughout a range of movement about a vertical axis. (It should be noted, however, that Japanese reference 8-258755 clearly is not capable of such movement about a vertical axis).

The present invention in stark contrast to the references, and as indicated in the new claims, comprises a tire support capable of supporting a tire throughout a plurality of

positions through which the tire and support are capable of travel about a horizontal axis.

Therefore, the references currently cited fail to teach or suggest all of the claimed limitations of the present invention. Accordingly, Applicant respectfully submits that the applied art does not anticipate the present invention because, at the very least, “[a]nticipation requires the disclosure in a single prior art reference of each element of the claim under construction.” *W.L. Gore & Associates, Inc. v. Garlock*, 721 F.2d 1540, 1554 (Fed. Cir. 1983); *see also In re Marshall*, 198 U.S.P.Q. 344, 346 (C.C.P.A. 1978).

Furthermore, a 35 U.S.C. §103(a) obviousness rejection requires three criteria be met, namely: (1) the combined references must teach or suggest all of the claim limitations; (2) a suggestion or motivation to make the modification or combination; and (3) a reasonable expectation of success. Currently, not only is there no motivation to combine the references or an expectation of success in doing so, actually combining the references would not produce the claimed invention, since all of the claimed elements are not taught. Thus, the claimed invention is patentable over the applied references and the state of the art.

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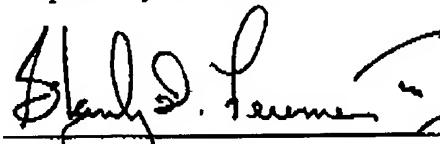
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Atty. Docket No. 575.040

In view of the foregoing, it is respectfully submitted that independent Claims 13 and 19 fully distinguish over the applied art and are thus in condition for allowance. By virtue of their dependence from Claims 13 and 19, it is thus, also, submitted that Claims 14-18 and 20-26 are allowable at this juncture. Notice to the effect is hereby earnestly solicited. If there are any further issues in this application, the Examiner is invited to contact the undersigned at the telephone number listed below.

Respectfully submitted,



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